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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,656	06/29/2001	Sandeep Dhar	81862P223	6850

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Kenneth B. Paley  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP  
Seventh Floor  
12400 Wilshire Boulevard  
Los Angeles, CA 90025-1026

EXAMINER
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JUNG, MIN

ART UNIT	PAPER NUMBER
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2663

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/895,656	<b>Applicant(s)</b>  DHAR ET AL.	
	<b>Examiner</b> Min Jung	<b>Art Unit</b> 2663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "destination hold circuit", "first destination receive circuit", "second destination receive circuit", "destination read circuit", "destination compose circuit", "processing device", "a first compose circuit", "a second compose circuit", "a transmit circuit", "a compare circuit", "a circuit to receive an information element", and "a circuit to transmit at least a portion of the information element" (Claims 1-8), "a first circuit", "a first receive circuit", "a second receive circuit", "read circuit", and "processing device" (Claims 27-29), etc. must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining

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figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims call for ATM transmission device including specific circuit elements such as "destination hold circuit", "first destination receive circuit", "second destination receive circuit", "destination read circuit", and "destination compose circuit", "processing device", "a first compose circuit", "a second compose circuit", "a transmit circuit", "a compare circuit", "a circuit to receive an information element", "a circuit to transmit at least a portion of the information element", etc. (Claims 1-8), and "a first circuit", "a first receive circuit", "a second receive circuit", "read circuit", "processing device" (Claims 27-29). Further, method claims call for

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the functions which are to be performed among the intended circuit elements.

However, the specification fails to provide a meaningful description of the recited circuit elements and interconnections and interactions among the recited circuit elements. First of all, there is no figure showing anything close to what is claimed in the apparatus claims. Thus, it is not known what the physical configuration of the claimed device is like. Second of all, the functional description based on the flow charts (Figs. 1a-1d) does not have clear correspondence to the claim limitations. For example, the portion of the specification at page 8, [0022] seems to describe loosely what is claimed in claim 1. However, i) it is difficult to determine whether the “selector code”, “selector identification”, and “selector content” all mean the same thing, or different things, ii) it is not clear what is being done with the comparison result (correspondence may mean an identity, etc. – what does that mean?), and iii) it takes a guess work to determine whether or not the subsequent data message reflected back is what is being claimed as a to-be transmitted second data.

Moreover, specification is very obscure in what is being done at the source transmission device and what is being done at the destination transmission device. In some portions of the specification, it seems that the connection is established between the source transmission device and the destination transmission device, and all the functions are performed between these two devices, however, in some other portions of the specification, the functions are described to be performed involving other entities (such as in page 6, [0014]). Further, at page 7, [0017] seems to describe opposite of what is

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shown at block 122 of Fig. 1a. Overall, the description is confusing and requires guess work to figure out what the content really means, probably mainly due to lack of description relating to meaningful drawing figures.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-8, 10-19, 21, and 23-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, all the circuit elements are recited as "destination" circuit elements; does it mean that the preamble should recite a "first ATM destination device" instead of "first ATM transmission device"? Also, by reciting a "transmission" device, is it applicant's intention to limit the function of it to "transmission" only? At line 3, it is not clear what the "determined selector identification" is all about – what is selector identification, and what is it determined from, and by what? At lines 4-5, it is not clear between what devices the "connection" is established. At lines 10-13, it is not clear what is the meaning of the "second message having a to-be transmitted second data---".

In claim 3, it is not clear what is meant by "the transmitted second data is the to-be received first data"; how is it possible for the transmitting entity to know what is to-be received in the future to transmit that data ahead of receiving it?

In claim 5, it is not clear if the second ATM transmission device is yet another device in addition to the recited "first ATM transmission device" "ATM source transmission device", and an implied 'destination device'. It is not clear

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how its functions are interrelated with the other recited devices. For example, is the first ATM data message from the ATM source transmission device or from the second ATM transmission device? Further, at lines 6-7, it is not clear what “an ATM transmission device” is referring to when the “transmit circuit” is included in the “second ATM transmission device”. At lines 8-9, it is not clear what “transmitted first data” and “received second data” are referring to since the point of transmission and reception are not clear and also because the terms are not consistent with one another (i.e., “the transmitted first data” vs. “first ATM data message”, and “the received second data” vs. “the second data message”, etc.).

In claim 10, lines 2-4, it is not clear if the “start up message” is yet another message sent in addition to the “setup message” and the “first data message”. Also, it is not clear if the “attaching” step is a sub-step of the “sending” step.

In claim 11, lines 2-3, it is not clear if “the second ATM device” is referring to the “second ATM transmission device”. At lines 5-6, it is not clear if “the second ATM transmission” should be “the second ATM transmission device”.

In claim 12, line 4, it seems that “sent” should be deleted.

In claim 13, lines 6-7, “having a received first data” seem to be a redundant language, which renders indefiniteness. At line 8, “the first address selector byte” lacks antecedent basis. At line 9, it is not clear what is meant by “a special address selector byte of the first transmission device” – is the address selector byte a portion of data describing the identity of the first transmission

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device, or is the byte simply stored in the first transmission device, or something else?

In claim 14, "line 3, "the data message" lacks antecedent basis.

In claim 16, it is not clear what is intended by reciting "an ATM transmission device", "a first ATM transmission device", "the ATM transmission device", and "the first ATM transmission device" in a confusing manner. At line 8, "the selector content" lacks antecedent basis. Throughout the claim, it is not made clear what is meant by "first selector content", "the selector content", and "a selector identification".

In claim 21, one of "at least one of" should be deleted.

In claim 23, lines 7-8, it is not clear what the functions of fourth means are; is it "reading" and "comparing"? How does the term "the destination" fit in with the rest of the recitation? At lines 9-12, it is not clear what the functions of the fifth means are. How does the term "the destination" fit in with the rest of the recitation?

In claim 25, it is not clear what is meant by "the transmitted second data is the to-be received first data"; how is it possible for the transmitting entity to know what is to-be received in the future to transmit that data ahead of receiving it?

In claim 26, "the setup message destination receive circuit means", "the data message destination receive circuit means", "the destination read circuit means", and "the destination compose circuit means" lack antecedent basis.

In claim 27, several terms are interchangeably (and not interchangeably) used and therefore are indefinite in meaning, therefore the usage of the terms



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“selector code byte identification”, “a selector code”, “the selector code byte identification from the source”, “a first selector content”, “the stored selector code byte identification”, and “the selector identification binary value” need to be clarified. At lines 7-8, it is not clear between what the connection is established.

In claim 28, “the to-be transmitted second data” lacks antecedent basis.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Gazier et al. Patent, the Davis et al. Patent, the Mauger et al. patent, the Jeong patent, and the Shirakawa patent are cited for further references.

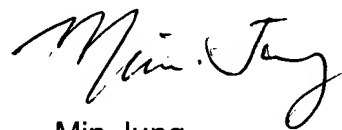
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Min Jung whose telephone number is 571-272-3127. The examiner can normally be reached on Monday, Thursday, Friday 7:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 703-272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ  
January 14, 2005



Min Jung  
Primary Examiner